

REMARKS

In the Office Action¹ mailed March 13, 2006, the Examiner took the following actions:

1) objected to claims 2, 3, 6, 7, 13, 15, 16, and 20 due to informalities;

2) rejected claims 1-11 and 13-20 under 35 U.S.C. § 103(a) as being unpatentable over Hirahara et al. (U.S. Patent No. 6,045,208, "Hirahara") in view of Delametter et al. (U.S. Patent No. 6,497,510 B1, "Delametter"); and

3) rejected claim 12 under 35 U.S.C. § 103(a) as being unpatentable over Hirahara in view of Delametter and further in view of Jeanmaire (U.S. Patent No. 6,866,370 B2, "Jeanmaire").

Applicant has cancelled claims 4 and 20 and added new claim 21. Claims 1-3, 5-19, and 21 are pending in the above-captioned patent application.

Independent claims 1, 18, and 21 have been amended to incorporate subject matter recited in claim 4, specifically "a droplet recovery member . . ." and to improve readability. Claim 1 is also amended to recite "the droplet recovery member is in contact with the surface of the printing liquid contained within the printing liquid containing chamber." Claims 18 and 21 are amended to recite similar limitations to claim 1. Support for these limitations can be found at, for example, in FIG. 1 of Applicant's specification. Claims 5-8 and 11-16 have been amended to depend from claim 1. In addition, claim 9 which depends from claim 1 has been amended to recite

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

“the image printing data” and to maintain consistency in light of the changes to claim 1. Furthermore, claim 15 has also been amended to maintain proper antecedent basis.

In addition, claims 2, 3, 6, 7, 13, 15, and 16 have been amended in a manner consistent with the Examiner’s comments at page 2 of the Office Action to correct various informalities and to improve readability. New claim 21 incorporates subject matter from claim 20 and includes changes consistent with the Examiner’s comments at page 2 of the Office Action. Accordingly, to the extent the objection still applies, Applicant respectfully requests the Examiner to reconsider and reverse the objection to claims 2, 3, 6, 7, 13, 15, 16, and 20.

Applicant respectfully traverses the rejection of claims 1-11 and 13-20 under 35 U.S.C. § 103(a) as being unpatentable over Hirahara in view of Delametter. Claims 4 and 20 are canceled rendering the rejection of these claims moot.

To establish a *prima facie* case of obviousness, three basic criteria must be satisfied. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine references. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all of the claim elements. See M.P.E.P. § 2143. Moreover, the requisite teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant’s disclosure. See *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). See M.P.E.P. § 706.02(j).

Claim 1 recites an acoustic inkjet printing apparatus including “a droplet recovery member provided adjacent to the printing liquid containing chamber, such that the droplet recovery member is in contact with the surface of the printing liquid contained within the printing liquid containing chamber.” Applicant respectfully traverses the rejection as neither Hirahara nor Delametter teach at least this element.

The Examiner apparently concedes that Hirahara fails to teach “a droplet recovery member . . .” and instead relies on Delametter to teach this claimed feature. Office Action at 4. In particular, the Examiner apparently associates the claimed “printing liquid containing chamber” with “a printing liquid containing chamber (15),” the claimed “printing liquid” with “printing liquid (18),” and the claimed “droplet recovery member” with gutter 9, respectively. Office Action at 3-4. Applicant notes that Delametter fails to disclose an element 15 and teaches that element 18 is a “wall,” (column 5, line 8), and thus the Examiner’s assertions appear misplaced.

In any event, to the extent the combination of wall 8 and dashed lateral flow lines 14 (apparently constituting a liquid) in Fig. 4A of Delametter corresponds to the claimed “printing liquid containing chamber containing a printing liquid,” Applicant notes that gutter 9 (the alleged “droplet recovery member”) does not contact a surface of the liquid within wall 8. Accordingly, Delametter fails to teach “a droplet recovery member provided adjacent to the printing liquid containing chamber, such that the droplet recovery member is in contact with the surface of the printing liquid contained within the printing liquid containing chamber,” (emphasis added) as recited in claim 1. Thus, no *prima facie* case of obviousness is established based on Hirahara and Delametter at

least because the references, either alone or in combination, fail to teach or suggest at least this element.

Independent claim 18 recites similar limitations to those recited in claim 1 and is not obvious based on Hirahara and Delametter for at least the reasons discussed above in regard to claim 1. Furthermore, claims 2, 3, and 5-17, and claim 19 depend from independent claims 1 and 18, respectively. Claims 2, 3, 5-17, and 19 are also not obvious for reasons similar to their respective independent claims. Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of pending claims 1-3 and 5-19 under 35 U.S.C. § 103(a).

Applicant respectfully traverses the rejection of claim 12 under 35 U.S.C. § 103(a) as being unpatentable over Hirahara in view of Delametter and further in view of Jeanmaire. Claim 12 depends from claim 1 and thus incorporates each and every element recited therein. Claim 1 is not obvious based on Hirahara nor Delametter at least because the references fail to teach or suggest a “droplet recovery member [] in contact with the surface of the printing liquid,” for the reasons discussed above. In FIG. 3a, Jeanmaire discloses recovery unit 30 formed opposite printhead 2. However, Jeanmaire also fails to teach or suggest a “droplet recovery member [] in contact with the surface of the printing liquid,” and thus fails to cure the above discussed deficiencies of Hirahara and Delametter. Accordingly, claim 1 is not rendered obvious by any combination of Hirahara, Delametter, and Jeanmaire, and thus claim 12 is allowable at least due to its dependence from claim 1. Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claim 12 under 35 U.S.C. § 103(a).

New claim 21 recites similar limitations to claim 1 and is thus also not obvious based on Hirahara, Delametter, and Jeanmaire, either alone or in combination, at least for the reasons noted above in regard to claim 1. Accordingly, Applicant submits that all pending claims 1-3, 5-19, and 21 are in condition for allowance and request prompt action by the Examiner in the form of a Notice of Allowance.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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